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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

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on June 15, 2010

Signature

Typed or printed name Peter J. Gutierrez, III

Application Number

10/707,733

Filed

January 8, 2004

First Named Inventor

Timothy N. Hentschel, et al.

Art Unit

3628

Examiner

Joseph, Tonya S.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)☒

attorney or agent of record.

Registration number 56,732☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

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June 15, 2010

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

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*Total of _____ forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

5 Applicant: Timothy N. Hentschel, et al. App. No.: 10/707,733
 Examiner: Joseph, Tonya S. Group Art Unit: 3628
 Filing date: January 8, 2004
 For: **ONLINE GROUP RESERVATION SYSTEM**

10 **PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Déar Sir or Madam:

15 In response to the Office Action dated March 15, 2010 ("Office Action"), Applicant herein requests a pre-appeal brief review of the above-identified application as follows:

I. **CLEAR ERROR IN ESTABLISHING A PRIMA FACIE CASE FOR OBVIOUSNESS UNDER 35 U.S.C. § 103**

20 Per page 2 of the Office Action, Claims 36 – 37, 59 – 60, 63 and 65 each stand rejected under 35 U.S.C. § 103 as being unpatentable over Moshal et al. (U.S. Patent Pub. No. 2001/0042041, hereinafter "Moshal") in view of Ghouri et al. (U.S. Patent Pub. No. 2002/0082978, hereinafter "Ghouri") and further in view of Norrid (U.S. Patent Pub. No. 2003/0061145, hereinafter "Norrid"). Applicant respectfully submits that the Examiner has
 25 committed clear and reversible error by failing to establish a *prima facie* case for obviousness in rejecting Claim 36.

30 Specifically, Applicant notes that the Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness (see MPEP § 2142). Furthermore, per MPEP § 2142:

35 *"The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in KSR International Co. v. Teleflex Inc., 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." In re Kahn, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also KSR, 550 U.S. at ___, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval)."*
 40 {emphasis added}

45 In rejecting Claim 36, the Examiner states at page 3, lines 14 – 16 of the Office Action that:

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"Moshal does not explicitly teach the limitation taught by Norrid providing an administrative monitoring application that monitor the status of commissions associated with a completed hotel reservation." {sic}

5 With regards to Norrid, the above reasoning is the *only* discussion provided by the Examiner.

10 Firstly, the Examiner has provided no articulation that Applicant can see for why such a combination or modification to Moshal would have been obvious. Rather, the Examiner merely presents a conclusory statement with no rational underpinning or argument for why such a proposed modification to Moshal would have been obvious as required by KSR. Moreover, per MPEP § 2143.01, the Examiner must provide a suggestion or motivation, which appears wholly absent from the Office Action.

15 Secondly, and on a separate and distinct basis, Applicant respectfully submits that the Examiner has committed clear and reversible error in not considering each and every limitation present within Applicant's Claim 36. It is well established that: *"All words in a claim must be considered in judging the patentability of that claim against the prior art."* *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). See also MPEP § 2143.03. As noted above, the Examiner in rejecting Claim 36 alleges that Norrid teaches *"providing an administrative monitoring application that monitor the status of commissions associated with a completed hotel reservation."* {sic} However, the limitation at issue in Claim 36 actually sets forth:

25 *"... providing an administrative monitoring application that communicates with said computer database in order to access information associated with said plurality of participating bidders as well as monitor the status of commissions associated with a completed hotel reservation."* {emphasis added}

30 Accordingly, even assuming *arguendo* that the Examiner's conclusory statement is true (which Applicant does not concede as set forth in an additional argument presented below), the Examiner has ignored relevant claim language; i.e., the Examiner has respectfully not even considered whether such an administrative monitoring application (as allegedly disclosed by Norrid) communicates with a computer database to access information associated with the plurality of participating bidders.

35 Therefore, for at least those reasons set forth above, Applicant submits that the Examiner has failed to establish a *prima facie* case for obviousness in rejecting at least Claim 36.

II. CLEAR ERROR IN ALLEGATIONS OF WHAT NORRID TEACHES

40 As discussed previously, Claim 36 sets forth and claims in part *"an administrative monitoring application that communicates with said computer database in order to ... monitor the status of commissions associated with a completed hotel reservation."* {emphasis added} The Examiner alleges that Norrid teaches such functionality as claimed at paragraphs [0018] – [0019] and [0072] of Norrid. Paragraph [0072] of Norrid sets forth:

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"Additionally, upon confirmation of the reservation, the Octopus 21 may consult the rates datastore 200, calculate the commissions due to the booking party, if any, and record those for payment later, thereby generating a revenue pool 28 under the control and specification of the hotel."

In other words, Norrid only teaches calculating the commissions due and recording those calculations for later payment. Norrid does not teach nor suggest monitoring the *status* of these calculated commissions (e.g., and without limitation, whether or not they have been paid). See also for example, paragraph [0031] of Applicant's specification as filed which sets forth in part:

"This figured is called the "Accounting Information Page" because it also contains the status of paid commissions on accepted groups. This allows an administrator to track all commissions that are received or become past due."

Accordingly, Applicant respectfully submits that the Examiner has committed clear and reversible error on this independent and distinct basis as well.


III. CONCLUSION

In summation, Applicant respectfully submits that the Examiner has committed clear and reversible error in at least those instances described above. Accordingly, Applicant requests that the Final Rejection for the above-identified case be withdrawn, and that the case be passed to allowance, or that a subsequent Office communication correcting the above highlighted deficiencies be issued.

Respectfully submitted,

GAZDZINSKI & ASSOCIATES, PC

Dated: June 15, 2010

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